



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,981	11/09/2001	Nicolas John Dougill	18872.0001	7856

7590

07/03/2003

Martin G. Linihan  
Hodgson Russ LLP  
Suite 2000  
One M&T Plaza  
Buffalo, NY 14203-2391

EXAMINER

ROSE, ROBERT A

ART UNIT

PAPER NUMBER

3723

DATE MAILED: 07/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
10/037,981

Applicant(s)  
Nicolas et al

Examiner  
Robert Rose

Art Unit  
3723



— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 14, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above, claim(s) 12-18, 30-36, and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6, 19-21, 24, and 37 is/are rejected.
- 7) ☒ Claim(s) 4, 5, 7-11, 22, 23, and 25-29 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3723

### DETAILED ACTION

1. Applicant's election without traverse of Group I, Claims 1-11, 19-29, and 37 drawn to a method and apparatus for removing material from a workpiece in Paper No. 8 is acknowledged.
2. Claims 12-18, 30-36, and 38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8.
3. Claims 4-5, 7-11, 22-23, and 25-29 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiply dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to point out what is included or excluded by the claim language. This claim is an omnibus type claim.
6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3723

7. Claims 1-3, 6, 19-21, 24, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballinger in view of <sup>Dempsey et al</sup> ~~Rukavina~~. Ballinger discloses a method and apparatus for removing material from a workpiece comprising all of the subject matter of applicant's claims above except for the recitation of means for detecting the load and means for controlling the rate of advancing movement depending upon the magnitude of the load. Note the use of an eccentric mount for oscillating the grinding wheel while it rotates about its central axis. Dempsey et al discloses a control means for a grinding wheel comprising means for detecting the load current of the grinding wheel motor indicative of the load applied to the grinding wheel from the workpiece, and means for controlling the feed motion of the grinding wheel based upon the magnitude of the detected load current. To use this control means in the apparatus and method of Ballinger to prevent overloading of the grinding wheel during machining would have been obvious in view of Dempsey et al.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rukavina et al is cited of interest to show a method of feeding a grinding wheel into a workpiece by sensing the load current of the grinding wheel and actuating the feed motor to move the grinding wheel toward the workpiece when the load current is below a specified level, and away from the workpiece when the load current is above a specified level. Bechem and Ainley are cited of interest to show other grinding wheel arrangements having means to rotate the grinding wheel about a central axis and means for mounting the grinding wheel to revolve about a second axis spaced from the first axis.

Art Unit: 3723

9. Any inquiry concerning this communication should be directed to Robert Rose at telephone number (703) 308-1360.

IT

June 24, 2003.

A handwritten signature in black ink, appearing to read "Robert A. Rose", is positioned above the typed name.

**ROBERT A. ROSE  
PRIMARY EXAMINER  
ART UNIT 323**